

Application No.: 10/083,884
Attorney Docket No.: 01-1002

REMARKS

In the Office Action dated December 15, 2004, the Examiner (1) rejected claims 1-9, 11-25 and 27-28 rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz et al. (U.S. Patent Application Publication No. 2002/0147811 A1) in view of Milewski et al. (U.S. Patent No. 6,519,326); and (2) rejected claims 10 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Schwartz et al. in view of Castagna et al. (U.S. Patent No. 6,442,245).

By this amendment, Applicants propose to amend claims 9-11, 17 and 24.
Claims 1-28 remain pending in this application.

In view of the above amendments and based on the following remarks, Applicants respectfully request reconsideration of this application and the timely allowance of pending claims 1-28. Each rejection set forth in the outstanding Office Action is addressed below.

Claims 1, 11 and 18

Claims 1, 11 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz et al. In view of Milewski et al. Applicants traverse these rejections for at least the following reasons.

Claim 1 recites "[a] method for supplying calling party information to a called party" comprising, *inter alia*:

receiving by the gateway device, via the telephone network, signaling information representing a telephone call from the calling party to a telephone device associated with the called party, the signaling information comprising called party information;

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obtaining the calling party information based on the signaling information; and

providing the calling party information to a second device associated with the called party and separate from the telephone device, via the data network.

Claim 1, ll. 5-13. Claims 11 and 18 contain recitations similar to those of claim 1. In addition, Applicants propose to amend claim 11 to correct a minor informality.

The Examiner concedes that Schwartz et al. "fails to teach providing calling party information on a second device associated with the called party." *Office Action*, p. 3, ll. 14-15. In order to cure this deficiency, however, the Examiner asserts that "[i]t would have been obvious ... to modify the PC as taught by Schwartz to incorporate call-screening as taught by Milewski for the benefit of notifying the called party via computer that an important incoming call is desired" *Office Action*, p. 4, ll. 4-7. However, Applicants respectfully disagree with the Examiners' interpretation of Schwartz et al. and Milewski et al.

First, the Examiner's reference to "the PC as taught by Schwartz" is not understood. Applicants can find no reference to a PC, or personal computer, in Schwartz et al. Consequently, if the Examiner maintains this rejection, Applicants respectfully request that the Examiner clarify the above statement in a new Office Action.

Second, the Examiner asserts that Milewski et al. "sends caller id information to [the] called [party's] computer ... which gives the called party the opportunity to screen incoming call[s]" *Office Action*, p. 4, ll. 1-2. However, contrary to the Examiner's assertions, Milewski et al. does not send Caller ID information to the called party's PC 155. Rather, Milewski et al. sends a "voice-announcement call request signal, or 'voice-

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ring" spoken by the calling party. See col. 3, ll. 7-24. The "voice-ring" is sent from the calling party's PC 105 to the called party's PC 155 prior the establishment of the voice connection between the calling party's telephone 110 and the called party's telephone. See col. 4, l. 52, through col. 5, l. 4. Therefore, the "voice-ring" does not include "calling party information based on ... signaling information" received by the gateway device via the telephone network, as set forth in claims 1, 11 and 18. Consequently, even assuming that the artisan would have been motivated to modify Schwartz et al. in view of Milewski et al. (which applicants dispute), the combination of Schwartz et al. and Milewski et al. does not teach the subject matter set forth in claims 1, 11 and 18.

For at least these reasons, claims 1, 11 and 18 are distinguished from Schwartz et al. or Milewski et al., whether taken alone or in combination. Accordingly, Applicants respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claim 10

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz et al. in view of Castagna et al. The Examiner admits that Schwartz et al. "fails to teach providing calling party information on a second device associated with the called party." *Office Action*, p. 7, ll. 1-2. However, the Examiner cites Castagna et al. for teaching displaying "incoming call information on [a] PC." *Office Action*, p. 7, ll. 19-20.

By this amendment, Applicants propose to amend Claim 10 to recite, *inter alia*:

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receiving, from the called party, an indication of one location, from among a plurality of locations, to which communications to the called party are to be directed; and

presenting the caller identification information to the called party by displaying an instant message provided by the instant messaging server on a second device associated with the *indicated location*.

Claim 10, ll. 22-28 (emphasis added). Support for these amendments may be found in at least paragraphs 039 and 056 of Applicants' original specification. By contrast, Castagna et al. displays the Caller ID information on a computer 18 that is located in the home 16 with telephone 14 (see col. 2, ll. 11-16, col. 3, ll. 17-21, and FIG. 1), without regard to "an indication of *one location, from among a plurality of locations*, to which communications to the called party are to be directed," as recited in the proposed amendment to Claim 10 (emphasis added).

For at least these reasons, amended claim 10 is distinguished from Schwartz et al. and Castagna et al., whether taken alone or in combination. Accordingly, Applicants respectfully request that the rejection of this claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Claims 2-9, 12-17 and 19-28

Initially, Applicants note that claims 9, 17 and 24 are amended herein in order to correct a typographical error. Support for these amendments may be found in at least paragraph 029 of Applicants' original specification.

Claims 2-9, 12-17 and 19-28 depend from one of claims 1, 10, 11 and 18. As explained, claims 1, 10, 11 and 18 are allowable over the prior art relied upon. Thus, claims 2-9, 12-17 and 19-28 are likewise allowable for at the reason that they depend

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from an allowable claim, and Applicants respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

Conclusion

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-28 in condition for allowance. Applicants submit that the proposed amendments of claims 9, 10, 17 and 24 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

In addition, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

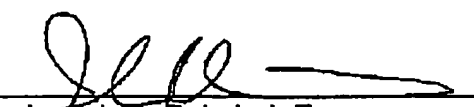
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Finally, Applicants note that the Office Action dated December 15, 2004, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is discussed herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2339 and please credit any excess fees to such deposit account.

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